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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/468,257	12/20/1999	ANGELA K. HANSON	10990314-1	3407

22879 7590 01/02/2003

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EXAMINER

POKRZYWA, JOSEPH R

ART UNIT	PAPER NUMBER
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2622

DATE MAILED: 01/02/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/468,257

Applicant(s)

HANSON ET AL.

Examiner

Joseph R. Pokrzywa

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 01 October 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 2-5, 7-20, 22 and 24-28 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 2-5, 7-20, 22 and 24-28 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_ 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Continued Examination Under 37 CFR 1.114*

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 10/1/02 has been entered.

### *Response to Preliminary Amendment*

2. Applicant's preliminary amendment was received on 10/1/02, and has been entered and made of record. Currently, **claims 2-5, 7-20, 22, and 24-28** are pending.

### *Claim Objections*

3. **Claims 2 through 4** are objected to because of the following informalities:

In **claim 2**, line 2, "said medium" should read "said document";

In **claim 3**, line 3, "said medium" should read "said document";

In **claim 4**, line 2, "said medium" should read "said document";

Appropriate correction is required.

***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. **Claims 2 through 4** are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

6. **Claim 2** recites the limitation "said locating step" in line 1. There is insufficient antecedent basis for this limitation in the claim.

7. **Claim 3** recites the limitation "said locating step" in line 1. There is insufficient antecedent basis for this limitation in the claim.

8. **Claim 4** recites the limitation "said locating step" in line 1. There is insufficient antecedent basis for this limitation in the claim.

***Claim Rejections - 35 USC § 102***

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

10. **Claims 2-5, 7, 8, 15-18, 20, 22, 24, 25, and 27** is rejected under 35 U.S.C. 102(b) as being anticipated by Witek (U.S. Patent Number 5,461,488).

Regarding **claim 2**, Witek discloses the method discussed below in claim 5, and further teaches that the scanning step (as understood by the examiner) comprises scanning the medium (column 2, line 49 through column 3, line 2).

Regarding **claim 3**, Witek discloses the method discussed below in claim 5, and further teaches that the scanning step (as understood by the examiner) comprises the step of locating the communication mark at a predetermined location on the medium (column 3, lines 3 through 65, on the cover sheet).

Regarding **claim 4**, Witek discloses the method discussed below in claim 5, and further teaches that the scanning step (as understood by the examiner) comprises a locating an address relative to a predetermined mark on the medium (column 3, lines 3 through 62).

Regarding **claim 5**, Witek discloses a method for providing automatic communication addressing comprising the steps of receiving a document from one from the group of a fax and an email communication and creating a hardcopy of the document (column 2, lines 16 through 23, column 2, lines 42 through 49, and column 4, line 57 through column 5, line 20, being a created pict file, which can subsequently be printed), without adding any address information,

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scanning the document to obtain at least one communication mark, if one is present, on the hardcopy (column 2, line 49 through column 3, line 62), decoding the communication mark to obtain at least a first communication address for a first communication mode and a second communication address for a second different type of communication mode directly or indirectly from the communication mark (column 2, line 65 through column 3, line 2, and column 3, line 37 through column 4, line 19, column 4, line 57 through 67, and column 6, lines 48 through 63), selecting one of the communication addresses and inputting the selected communication address into an address function of a communication device (column 3, line 63 through column 4, line 9, and column 6, lines 42 through 66), and initiating a communication of the information to the communication address through the communication device (column 6, line 60 through column 7, line 5).

Regarding *claim 7*, Witek discloses the method discussed above in claim 5, and further teaches that the communication device comprises at least two different types of communication modes (column 3, line 63 through column 4, line 9, and column 6, lines 48 through 66).

Regarding *claim 8*, Witek discloses the method discussed above in claim 5, and further teaches of the step of adding a communication mark to the information prior to initiating the communication (column 5, line 64 through column 6, line 30).

Regarding *claim 15*, Witek discloses a method for providing automatic communication addressing comprising the steps of locating a communication mark, if one is present, on a medium containing information (column 2, line 42 through column 3, line 41), obtaining at least one communication address directly or indirectly from the communication mark (column 3, line 37 through column 4, line 9), inputting the communication address into an address function of a

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communication device (column 3, line 63 through column 4, line 9, and column 6, lines 42 through 66), and initiating a communication of the information to the communication address through the communications device (column 6, line 60 through column 7, line 5), wherein the communication mark includes a first communication address for a first communication mode, and a second communication address for a second different type of communication mode (column 2, line 65 through column 3, line 2, and column 3, line 37 through column 4, line 19, column 4, line 57 through 67, and column 6, lines 48 through 63), further comprising the steps of determining if the communication mode for the first communication address is available at the communication device (column 4, lines 57 through 61), and when it is determined that the communication mode for the first communication address is not available at the communication device, sending the second communication address for the second different type of communication mode and the information to the communication device (column 4, line 57 through column 5, line 3, and column 6, lines 52 through 59).

Regarding *claim 16*, Witek discloses the method discussed above in claim 5, and further teaches of the step of storing the address obtained directly or indirectly from the communication mark (column 2, lines 26 through 65, and column 6, lines 31 through 59).

Regarding *claim 17*, Witek discloses the method discussed above in claim 5, and further teaches of the step of determining a name of an addressee corresponding to the obtained address (column 3, line 36 through column 4, line 9), and displaying the addressee name to a user (column 6, lines 48 through 59).

Regarding *claim 18*, Witek discloses the method discussed above in claim 5, and further teaches of the step of adding a new communication mark to the information includes directly or

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indirectly a new address to be obtained relative to the obtained at least one address (column 3, lines 3 through 62, and column 5, line 64 through column 6, line 9).

Regarding *claim 20*, Witek discloses a system for providing automatic communication addressing comprising logic for locating a communication mark on a medium containing information (column 2, line 42 through column 3, line 41), wherein the communication mark includes a first communication address for a first communication mode, and a second communication address for a second different type of communication mode (column 2, line 65 through column 3, line 2, and column 3, line 37 through column 4, line 19, column 4, line 57 through 67, and column 6, lines 48 through 63), logic for obtaining at least one address directly or indirectly from the communication mark (column 3, line 37 through column 4, line 9), logic for inputting the address into an address function of a communication device (column 3, line 63 through column 4, line 9, and column 6, lines 42 through 66), and logic for initiating a communication of the information to the address through the communications device (column 6, line 60 through column 7, line 5).

Regarding *claim 22*, Witek discloses a system for providing automatic communication addressing comprising logic for locating a communication mark, if one is present, on a medium containing information (column 2, line 42 through column 3, line 41), logic for obtaining at least one communication address directly or indirectly from the communication mark (column 3, line 37 through column 4, line 9), logic for inputting the communication address into an address function of a communication device (column 3, line 63 through column 4, line 9, and column 6, lines 42 through 66), and logic for initiating a communication of the information to the communication address through the communications device (column 6, line 60 through column



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7, line 5), wherein the communication mark includes a first communication address for a first communication mode, and a second communication address for a second different type of communication mode (column 2, line 65 through column 3, line 2, and column 3, line 37 through column 4, line 19, column 4, line 57 through 67, and column 6, lines 48 through 63), further comprising logic for determining if the communication mode for the first communication address is available at the communication device (column 4, lines 57 through 61), and logic for, when it is determined that the communication mode for the first communication address is not available at the communication device, sending the second communication address for the second different type of communication mode and the information to the communication device (column 4, line 57 through column 5, line 3, and column 6, lines 52 through 59).

Regarding *claim 24*, Witek discloses a program product including machine readable program code for causing a machine (column 4, lines 20 through 31, and column 7, lines 6 through 15) to perform the following method steps for providing automatic communication addressing comprising locating a communication mark, if one is present, on a medium containing information (column 2, line 42 through column 3, line 41), obtaining at least one communication address directly or indirectly from the communication mark (column 3, line 37 through column 4, line 9), inputting the communication address into an address function of a communication device (column 3, line 63 through column 4, line 9, and column 6, lines 42 through 66), and initiating a communication of the information to the communication address through the communications device (column 6, line 60 through column 7, line 5), wherein the communication mark includes a first communication address for a first communication mode, and a second communication address for a second different type of communication mode

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(column 2, line 65 through column 3, line 2, and column 3, line 37 through column 4, line 19, column 4, line 57 through 67, and column 6, lines 48 through 63), further comprising the steps of determining if the communication mode for the first communication address is available at the communication device (column 4, lines 57 through 61), and when it is determined that the communication mode for the first communication address is not available at the communication device, sending the second communication address for the second different type of communication mode and the information to the communication device (column 4, line 57 through column 5, line 3, and column 6, lines 52 through 59).

Regarding *claim 25*, Witek discloses a program product for providing automatic communication addressing, comprising machine-readable program code for causing a machine (column 4, lines 20 through 31, and column 7, lines 6 through 15) to perform the following method, comprising receiving a document from one from the group of a fax and an email communication and creating a hardcopy of the document (column 2, lines 16 through 23, column 2, lines 42 through 49, and column 4, line 57 through column 5, line 20, being a created pict file, which can subsequently be printed), without adding any address information, scanning the document to obtain at least one communication mark, if one is present, on the hardcopy (column 2, line 49 through column 3, line 62), decoding the communication mark to obtain at least a first communication address for a first communication mode and a second communication address for a second different type of communication mode directly or indirectly from the communication mark (column 2, line 65 through column 3, line 2, and column 3, line 37 through column 4, line 19, column 4, line 57 through 67, and column 6, lines 48 through 63), selecting one of the communication addresses and inputting the selected communication address into an address

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function of a communication device (column 3, line 63 through column 4, line 9, and column 6, lines 42 through 66), and initiating a communication of the information to the communication address through the communication device (column 6, line 60 through column 7, line 5).

Regarding *claim 27*, Witek discloses a system for providing automatic communication addressing comprising logic for receiving a document from one from the group of a fax and an email communication and creating a hardcopy of the document (column 2, lines 16 through 23, column 2, lines 42 through 49, and column 4, line 57 through column 5, line 20, being a created pict file, which can subsequently be printed), logic for, without adding any address information, scanning the document to obtain at least one communication mark, if one is present, on the hardcopy (column 2, line 49 through column 3, line 62), logic for decoding the communication mark to obtain at least a first communication address for a first communication mode and a second communication address for a second different type of communication mode directly or indirectly from the communication mark (column 2, line 65 through column 3, line 2, and column 3, line 37 through column 4, line 19, column 4, line 57 through 67, and column 6, lines 48 through 63), logic for selecting one of the communication addresses and inputting the selected communication address into an address function of a communication device (column 3, line 63 through column 4, line 9, and column 6, lines 42 through 66), and logic for initiating a communication of the information to the communication address through the communication device (column 6, line 60 through column 7, line 5).

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11. **Claims 11-13, 26, and 28** are rejected under 35 U.S.C. 102(b) as being anticipated by Cass (U.S. Patent Number 5,692,073).

Regarding *claim 11*, Cass discloses a method for providing automatic communication addressing comprising the steps of receiving a document from one from the group of a fax and an email communication and creating a hardcopy of the document (column 17, lines 54 through 67), without adding any address information, scanning the document to obtain at least one communication mark, if one is present, on the hardcopy (column 16, line 65 through column 17, line 16), decoding the communication mark to obtain at least one Internet address from the communication mark automatically accessing a site for the Internet address and retrieving at least one communication address (column 18, lines 7 through 34), inputting the communication address into an address function of a communication device (column 18, lines 12 through 53), and initiating a communication of the information to the communication address through the communication device (column 18, line 54 through column 19, line 55), wherein the communication mark is a storage address to a location where a communication address is stored (column 18, line 35 through column 19, line 42).

Regarding *claim 12*, Cass discloses the method discussed above in claim 11, and further teaches of a step of accessing the storage address over a network to obtain the communication address (column 18, lines 7 through 65).

Regarding *claim 13*, Cass discloses the method discussed above in claim 11, and further teaches of a step of accessing a URL address wherein the communication device is located (column 18, lines 7 through 65).

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Regarding *claim 26*, Cass discloses a program product for providing automatic communication addressing, comprising machine-readable program code for causing a machine to perform the following method (column 7, lines 35 through 55), comprising receiving a document from one from the group of a fax and an email communication and creating a hardcopy of the document (column 17, lines 54 through 67), without adding any address information, scanning the document to obtain at least one communication mark, if one is present, on the hardcopy (column 16, line 65 through column 17, line 16), decoding the communication mark to obtain at least one Internet address from the communication mark automatically accessing a site for the Internet address and retrieving at least one communication address (column 18, lines 7 through 34), inputting the communication address into an address function of a communication device (column 18, lines 12 through 53), and initiating a communication of the information to the communication address through the communication device (column 18, line 54 through column 19, line 55), wherein the communication mark is a storage address to a location where a communication address is stored (column 18, line 35 through column 19, line 42).

Regarding *claim 28*, Cass discloses a system for providing automatic communication addressing comprising logic for receiving a document from one from the group of a fax and an email communication and creating a hardcopy of the document (column 17, lines 54 through 67), logic for, without adding any address information, scanning the document to obtain at least one communication mark, if one is present, on the hardcopy (column 16, line 65 through column 17, line 16), logic for decoding the communication mark to obtain at least one Internet address from the communication mark, logic for automatically accessing a site for the Internet address and retrieving at least one communication address (column 18, lines 7 through 34), logic for

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inputting the communication address into an address function of a communication device (column 18, lines 12 through 53), and logic for initiating a communication of the information to the communication address through the communication device (column 18, line 54 through column 19, line 55).

***Claim Rejections - 35 USC § 103***

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

13. **Claims 9 and 10** are rejected under 35 U.S.C. 103(a) as being unpatentable over Witek (U.S. Patent Number 5,461,488) in view of Geshwind (WIPO Publication Number WO 96/41463).

Regarding **claims 9 and 10**, Witek discloses the method discussed above in claim 5, but fails to particularly teach if the communication mark is a bar code, and if the communication mark is not visible to the unaided human eye. Geshwind teaches of a method for providing automatic communication addressing (see abstract, and page 6, lines 9 through 42) comprising the steps of receiving a document from one from the group of a fax and an email communication (see Fig. 6), without adding any address information, scanning the document to obtain at least one communication mark, if one is present (see Fig. 6), decoding the communication mark to obtain at least a first communication address for a first communication mode directly or indirectly from the communication mark (page 8 through 28). Further, Geshwind teaches of the

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communication mark being a bar code (see abstract, page 4, line 37 through page 5, line 3, and page 6, lines 9 through 42), and the communication mark being not visible to the human eye (see abstract, page 5, lines 13 through 30, and page 6, line 9 through page 7, line 14). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to include Geshwind's teachings in the system of Witek. Witek's system would easily be modified to include Geshwind's teachings, as the systems share cumulative features, being additive in nature.

14. **Claims 14 and 19** are rejected under 35 U.S.C. 103(a) as being unpatentable over Witek (U.S. Patent Number 5,461,488) in view of Cass (U.S. Patent Number 5,692,073).

Regarding *claim 14*, Witek discloses the method discussed above in claim 5, but fails to particularly teach if the communication device is a voice communication device. Cass discloses a method for providing automatic communication addressing comprising the steps of receiving a document from one from the group of a fax and an email communication and creating a hardcopy of the document (column 17, lines 54 through 67), without adding any address information, scanning the document to obtain at least one communication mark, if one is present, on the hardcopy (column 16, line 65 through column 17, line 16), decoding the communication mark to obtain at least one address from the communication mark (column 18, lines 7 through 34). Cass further teaches that the communication device is a voice communication device (see Fig. 2, column 1, lines 31 through 60, wherein a standard facsimile machine, as well as a multifunction device inherently include the capability of voice communication). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was

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made to include the teachings of Cass in Witek's system. Witek's system would easily be modified to include the teachings of Cass, as the systems share cumulative features, being additive in nature.

Regarding *claim 19*, Witek discloses the method discussed above in claim 5, but fails to teach of the step of adding a communication mark to the information that deletes an address or a reference to an address from the located communication mark. Cass discloses a method for providing automatic communication addressing comprising the steps of receiving a document from one from the group of a fax and an email communication and creating a hardcopy of the document (column 17, lines 54 through 67), without adding any address information, scanning the document to obtain at least one communication mark, if one is present, on the hardcopy (column 16, line 65 through column 17, line 16), decoding the communication mark to obtain at least one address from the communication mark (column 18, lines 7 through 34). Cass further teaches of the step of adding a communication mark to the information that deletes an address or a reference to an address from the located communication mark (column 17, line 50 through column 18, line 65). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to include the teachings of Cass in Witek's system. Witek's system would easily be modified to include the teachings of Cass, as the systems share cumulative features, being additive in nature.



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*Citation of Pertinent Prior Art*

15. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

**Krtolica** (U.S. Patent Number 5,974,177) discloses a system for distributing documents based on detected scanned symbols;

**Baran** (U.S. Patent Number 5,247,591) discloses a system for routing a facsimile document to a plurality of recipients.

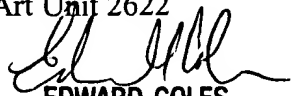
*Conclusion*

16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joe Pokrzywa whose telephone number is (703) 305-0146. The examiner can normally be reached on Monday-Friday, 7:30-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward L. Coles can be reached on (703) 305-4712. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9314 for regular communications and (703) 872-9314 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 306-0377.

jrj  
December 29, 2002

J.R.P.  
Joseph R. Pokrzywa  
Examiner  
Art Unit 2622  
  
EDWARD COLES  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2600